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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,165	04/18/2001	Jacqueline A. Haynes	0913.0006C	7406
7590	08/03/2004		EXAMINER	
EPSTEIN & GERKEN 1901 RESEARCH BOULEVARD SUITE 340 ROCKVILLE, MD 20850-3164				CHRISTMAN, KATHLEEN M
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/836,165	HAYNES ET AL.
	Examiner	Art Unit
	Kathleen M Christman	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 April 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 5-17, 26-36, 38, and 41-44 is/are allowed.
- 6) Claim(s) 1-4, 18-25, 37, 39 and 40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/29/2004.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

#### **DETAILED ACTION**

In response to the amendment filed 04/29/2004, claims 1-44 are pending.

#### ***Specification***

The incorporation of essential material in the specification by reference to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 04/29/2004 has been considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not clearly set forth the how "the semantic space is derived from latent semantic analysis using a latent semantic analysis algorithm", the semantic space derived from HAL, or the semantic space derived from EM.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-4, 19, 19, 22-25, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontana et al (US 6,361,326 B1) in view of Berman (US 6461166 B1) for the reasons set forth in the office action dated 01/30/2004 and hereby incorporated by reference.

***Allowable Subject Matter***

3. Claims 5-17, 26-36, 38, and 41-44 are allowed.
4. The following is an examiner's statement of reasons for allowance: The prior art fails to teach the specific combination of elements as particularly claimed. Specifically the prior art fails to teach the use of

a comprehension tutor module which presents a student with interactive summarizing instruction and exercises (claims 5-10, 28-33); a vocabulary tutoring module (claims 11-16); and a fluency tutor module (claim 17); automatically selecting a next passage based upon both the user's a measure of the student's reading comprehension and the congruence of the summary to the selected reading passage (claim 26-27, 34-36); the student self-selecting the domain of discourse (claim 38); the ability for a student to submit a practice summary (claim 41); the ability for the student to receive information on principal vocabulary words (claim 42) including interactive exercises(claim 43); or the production of an audibly correct reading of the selected reading passage (claim 44); within a system or method including a domain of discourse including a plurality of instructional passages which are accessible to a student wherein the instructional passages are of predetermined difficulty levels in combination with a semantic space method means which receives and scores a student's summary of at least one of the instructional passages and determines the instructional passage which the user is to read next in combination with immediate feedback data provided to the student to indicating the congruence of the summary with the instructional passage.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

5. The objection to the IDS filed 08/09/2002 has been corrected with the new IDS submission. The rejection of claim 3, under 35 USC §112, second paragraph has been overcome by the amendment to the claim.

6. Applicant's arguments filed 04/29/2004 have been fully considered but they are not persuasive.

Rejections under 35 USC §112, first paragraph

The applicant has argued that the limitations of claim 19 are fully taught by the specification as originally filed. However, the applicant has made no attempt to specifically point to where in the specification as originally filed such teachings may be found. The examiner notes that the feature of deriving the semantic space from latent semantic analysis is mentioned in the specification, see page 13, line 18+, this passage does not show how to derive such a space for the intended purpose of the invention. Regarding claims 20 and 21, the applicant has stated that the Lund and Dempster articles fully enable one of ordinary skill in the art to create such spaces. This results in an admission that the articles contain essential subject matter. However, it is the examiner's position that although these articles teach that the semantic algorithms of HAL and M exist, they do not teach how one of ordinary skill in the art would implement either to perform the functions of the claimed invention.

Rejections under 35 USC §103(a)

Applicant's first assertion is that Fontana discloses a system for teaching thinking skills and is not related to reading tutoring (last paragraph starting on page 29 of the response dated 04/29/2004). The only mention of reading in the claims is recited in the preamble. Where a "reading tutoring system", is a preamble term that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the term does not limit the structure of the claimed device. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, the term recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand-alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Therefore the structural limitations of the claims are interpreted in and of themselves. As the necessity for the

system to be directly related to the reading is not required applicant's arguments concerning such are moot. Further all arguments based upon this assertion are moot.

Applicant secondly argues that Fontana et al is not capable of receiving responses, much less summaries, from the user and as such the intended modifications suggested by the examiner are not possible (page 30 of the response date 04/29/2004). Fontana et al teaches multiple occasions where the user of the system enters "input". Each of these inputs are analyzed by the system so as to determine which responses are to be outputted to the user. These features are taught in at least col. 2: 55 – col. 3: 8. Further Fontana et al in no manner limits the type of materials used therewith.

Applicant further argues that Berman fails to rectify the supposed deficiencies of Fontana et al. On page 32 of the response applicant asserts that Berman is also not directed to reading instruction or tutoring. For the reason's set forth above the examiner maintains that the recitation of reading instruction is non-limiting in the claim.

Applicant's other arguments are directed to supposed flaws in the examiner's combinations based upon the above assertion that reading instruction is limiting to the claim. For the reason's set forth above, the examiner has shown that this is a non-limiting feature. As such the remainder of applicant's arguments are not commensurate with the scope of the claims.

The examiner notes that the applicant has not challenged the examiner's statement that it is old and well known in the area of adaptive educational systems to include questions, topics, or content at a variety of difficulty levels so as to allow the system to adapt the content presented to the user's learning level. As such the statement is now considered to be admitted prior art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3713

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

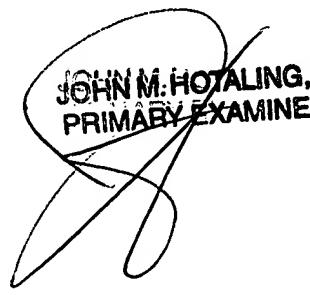
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M. Christman



JOHN M. HOTALING, II  
PRIMARY EXAMINER